

REMARKS/ARGUMENTS

Claims 1-21 are present in this application. By this Amendment, the title of the invention, the Abstract of the Disclosure and specification have been amended, and claims 20 and 21 have been added. Reconsideration in view of the above amendments and the following remarks is respectfully requested.

With regard to the objections to the specification, the title of the invention and the Abstract of the Disclosure have been amended to more clearly reflect the elected invention. Withdrawal of the objections is requested.

Claims 10-13 were rejected under 35 U.S.C. §112, first paragraph. The Office Action contends that the specification does not disclose specifically what material the “content of particle components” consists of. Clay, however, naturally contains particle components, the amount and size of which are a function of its impurity content. The “particle components” are thus not added to the clay as contended in the Office Action. The recitation in claim 10 of the characteristics of the clay serves to establish a maximum impurity content (i.e., clay with particle components that have a particle size of 5 µm or larger of not higher than 30% by weight based on the weight of the clay). Applicants submit that this would be clear to those of ordinary skill in the art. Moreover, the specification references suitable types of clay, one of which is preferred “because of its high binder effect and small impurity content.” See page 18, lines 17-20. Still further, the specification describes that the clay can be purified by separation to thereby adjust the content of the particle components. See page 19, line 1 – page 20, line 15.

Applicants thus respectfully submit that the specification and claims satisfy the requirements of 35 U.S.C. §112. Withdrawal of the rejection is respectfully requested.

Claims 10, 12 and 13 were rejected under 35 U.S.C. §102(b) over U.S. Published Patent Application No. 2003/0181302 to Kaiser et al. This rejection is respectfully traversed.

With reference to the Office Action, the Examiner takes the position that the Kaiser publication meets the limitation in claim 10 reciting that the disc members comprise an inorganic fiber, mica and a clay having a content of particle size 5 μm or larger of not higher than 30% by weight based on the weight of the clay. In this context, it seems the Examiner is making an assumption that since Kaiser is silent with regard to particle components of its clay, it follows that the clay has no particle components (the Office Action suggests that the clay in Kaiser includes 0% particle components). Applicants respectfully submit that this characterization of the Kaiser publication is technically inaccurate. That is, it does not follow that a lack of specific disclosure in the Kaiser publication translates to disclosing the use of clay entirely without particle components. Rather, the impurity content of the clay in the Kaiser structure is not pertinent to its invention, and the percentage of particle components is simply not disclosed.

Without a specific disclosure relating to the impurity content of the clay in Kaiser, presumably it is the Examiner's contention that this feature of the invention is inherent in Kaiser. To the contrary, however, the Federal Circuit provided in *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 20 USPQ 2d 1746, 1749 (Fed. Cir. 1991), that "To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill" (emphasis provided), citing *In re Oelrich*, 212 USPQ 323, 326 (C.C.P.A. 1981). "Inherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is

not sufficient.” *Hansgirg v. Kemmer*, 40 USPQ 665, 667 (C.C.P.A. 1939). It is clear that the construction of the disc members in Kaiser does not necessarily include clay entirely without particle components or of any particular impurity content.

Applicants thus respectfully submit that the rejection is misplaced.

With regard to dependent claims 12 and 13, Applicants submit that these claims are allowable at least by virtue of their dependency on an allowable independent claim.

Reconsideration and withdrawal of the rejection are respectfully requested.

Claim 11 was rejected under 35 U.S.C. §103(a) over Kaiser in view of U.S. Patent No. 4,533,581 to Asaumi et al. The Asaumi patent, however, does not correct the deficiencies noted above with regard to Kaiser. That is, neither reference provides any suggestion to modify the Kaiser discs to utilize the claimed materials. As such, Applicants submit that this dependent claim is allowable at least by virtue of its dependency on an allowable independent claim.

Claims 20 and 21 have been added, including a feature wherein the clay is either elutriated or subjected to a wet sizing separation purification process. At least this subject matter is lacking in the references of record.

In view of the foregoing amendments and remarks, Applicants respectfully submit that the claims are patentable over the art of record and that the application is in condition for allowance. Should the Examiner believe that anything further is desirable in order to place the application in condition for allowance, the Examiner is invited to contact Applicants’ undersigned attorney at the telephone number listed below.

Prompt passage to issuance is earnestly solicited.

NAKAYAMA et al.
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Respectfully submitted,

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